



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#16
9-8-03

Applicant: Mark James Yunker)
Serial No.: 09/904,387) Group Art Unit: 3653
Filed: 07/12/2001) Examiner: Daniel K. Schlak
For: Slide For Sorting Machine)

August 27, 2003

Mail Stop Petitions
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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**RENEWED PETITION TO WITHDRAW THE HOLDING OF ABANDONMENT
UNDER 37 CFR 1.181**

Sir:

This paper is submitted in response to the Decision on Petition to Withdraw the Holding of Abandonment mailed on July 21, 2003. Sections of the paper are as follows:

Statement of facts begins on page 2 of this paper.


Discussion begins on page 3 of this paper.

Appendix begins on page 7 of this paper.

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.10

I hereby certify that this correspondence is being deposited with the United States Postal Service on the date shown below in an envelope as "Express Mail Post Office to Addressee": Mailing Label Number ER 216 164 135 US addressed to "Mail Stop Petitions, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450."

Date: 8/27/03


Kenneth A. Keeling
Registration No. 31,842

STATEMENT OF FACTS

Kenneth A. Keeling, attorney of record for assignee Satake USA, Inc. (hereinafter "Satake"), requests that the holding of abandonment of application serial number 09/904,387 (the "'387 application") be withdrawn.

On October 9, 2002, a non-final Office Action (the "Office action of October 9") for the '387 application was mailed to the law firm of Bracewell and Patterson. (Exhibit 1). The Office Action of October 9 was received by Bracewell and Patterson on October 17, 2002 and, due to the client's desire to change attorneys for this application, forwarded to Mr. Keeling at Keeling Hudson, L.L.C. (hereinafter "Keeling Hudson"). (Exhibit 1). The Office Action of October 9 set a shortened statutory period of three months in which to file a reply. (Exhibit 1).

Between October 22, 2002 and December 16, 2002, Mr. Keeling worked on a response to the Office Action of October 9 (hereinafter "the reply"). On December 16, 2002, the reply was last saved to the Keeling Hudson server. (Exhibit 2).

The reply included a certificate of transmission. Mr. Keeling signed the certificate of transmission on the reply, dated it Thursday, December 26, 2002 and tendered it to the legal assistant responsible for filing such materials, Michelle Miley. (Exhibit 3). The document was to be transmitted December 26, 2002 by Michelle Miley. The reply was transmitted, via facsimile to the USPTO on December 27, 2002. (Exhibits 4 and 5 and Affidavit of Kenneth A. Keeling), thirteen days before the end of the shortened statutory period.

On April 21, 2003, Mr. Keeling received notice from Examiner Schlack at the USPTO indicating that a notice of abandonment was to be issued for the '387 application because a response to the Office Action of October 9 was not received. (Affidavit of Kenneth A. Keeling). Mr. Keeling then transmitted documentation via facsimile to Examiner Schlack that showed the

transmission of the reply was received by the USPTO within the shortened statutory period. (Affidavit of Kenneth A. Keeling and Exhibits 6 and 7).

On April 23, 2003 Michelle Miley talked with Examiner Schlack twice and others at the USPTO a total of five times to locate the facsimile transmission of April 21, 2003. (Exhibit 8). The facsimile transmission of April 23, 2003, which was 25 pages in length, was ultimately hand delivered to Examiner Schlack. (Exhibit 8).

On June 27, 2003, Examiner Luu called Keeling Hudson to request a statement pursuant to Rule 1.8(b)(3) regarding facts surrounding the timely response to an Office Action. A statement was prepared and sent via facsimile on the same day. (Exhibit 9).

On July 21, 2003, the USPTO mailed the Decision on Petition to Withdraw the Holding of Abandonment. The Petition was denied and a Notice of Abandonment was mailed on July 31, 2003.

DISCUSSION

The '387 application should not be held abandoned as the response was timely received by the USPTO. The Office Action of October 9 set a three-month period for reply, resulting in a response deadline of January 9, 2003. According to facsimile confirmation records, a response to the Office Action of October 9, 2002 was successfully received by the USPTO on December 27, 2002, well within the three month shortened statutory period.

37 CFR §1.6 (d) addresses facsimile transmissions to the USPTO. Facsimile transmissions are permitted except in certain enumerated cases. Correspondence that cannot be accepted by facsimile includes correspondence that cannot receive the benefit of a certificate of mailing or transmission as specified in §1.8 (a) (2) (i) (A) through (D) and (F), §1.8 (a) (2) (ii) (A), and Sec 1.8 (a) (2) (iii) (A). 37 CFR §1.6 (d).

37 CFR §1.8 (a) (2) (ii) (A) and 37 CFR §1.8 (a) (2) (iii) (A) relate to the filing of trademark applications and correspondence filed in connection with a disciplinary proceeding, respectively. Thus, these sections are irrelevant to this discussion.

37 CFR §1.8 (a) (2) (i) (A) through (D) and (F) sets out specific instances where a certificate of mailing or transmission does not apply. The instances in which a certificate of mailing or transmission does not apply to determine the receipt date of the correspondence are as follows: (1) the filing of a national patent application, (2) correspondence required by examiner-in-chief to be hand filed or express mailed, (3) agreements between parties to interference proceedings, (4) filing of international patent applications, and (5) filing a copy of the international application and basic national fee necessary to enter the national stage. None of the enumerated situations refers to the filing of responses to Office Actions. Because responses to Office Actions are not specifically excluded by the relevant portions of §1.8 with respect to the use of a certificate of mailing or transmission, they are not excluded from the correspondence that may be filed by facsimile under 27 USC §1.6 (d).

For correspondence properly transmitted via facsimile to the USPTO, “the receipt date accorded to the correspondence will be the date on which the complete transmission is received in the Patent and Trademark Office, unless that date is a Saturday, Sunday, or Federal holiday within the District of Columbia.” 37 CFR 1.6 (d). December 27, 2002 was a Friday and was not a Federal holiday within the District of Columbia. The confirmation for the facsimile transmission verifies that the USPTO received the transmission on December 27, 2002.

Section 1.8(a) provides for the consideration of timely filing when the correspondence is transmitted before the expiration of the set period of time, transmitted in accord with §1.6(d) and “includes a certificate for a piece of correspondence stating the date of deposit or transmission” with the person signing the certificate having a reasonable basis to expect that the correspondence would

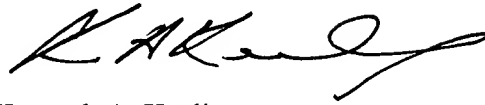
be transmitted on or before the date indicated. 37 USC §1.8 (a). The actual date of receipt is used when the procedure in §1.8 is not followed. 37 USC §1.8 (a).

In this case, the procedure in §1.8 was followed to the extent that the correspondence was transmitted before the expiration of the set period of time and included a certificate. Admittedly, a mistake is present as the certificate of transmission dated December 26, 2002 was actually transmitted on December 27, 2002. The certificate erroneously stated the date, however the certificate was signed and dated in good faith and the response was transmitted and received by the USPTO within one day. The fact that there were still two weeks before the deadline to file the response to the Office Action without paying extension fees and several months before the expiration of the period for response with the payment of extension fees is indicative of the good faith present in timely submitting the reply.

The holding of abandonment was apparently upheld based upon a difference between the date on the certificate of transmission and the actual date of transmission set out in Mr. Keeling's statement. Because the date on the certificate was not the date on which the transmission occurred, both §1.8 (a) and §1.6 (d) indicate that the date of receipt of the correspondence should then be the accorded filing date. According to both Mr. Keeling's statement and the confirmation of successful receipt by the facsimile machine at the USPTO, the actual date that the USPTO received the reply to the Office Action of October 9 was December 27, 2002. This date is within the shortened statutory period and should be the accorded filing date of the reply.

It is respectfully requested that Office reconsider this case and withdraw the holding of abandonment for the '387 patent application.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'K A Keeling', with a stylized flourish at the end.

Kenneth A. Keeling
Registration No. 31,842

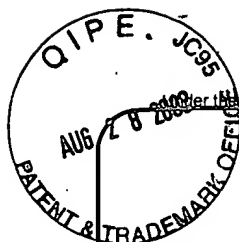
Keeling Hudson LLC
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(713) 680-1447
(713) 680-8567 Fax

APPENDIX

Affidavit of Kenneth Keeling	28 pages
Exhibit 1 USPTO Correspondence	1 page
Exhibit 2 Computer Screen Print	1 page
Exhibit 3 Response to Office Action	16 pages
Exhibit 4 Facsimile Cover Sheet	1 page
Exhibit 5 Facsimile Confirmation	1 page
Exhibit 6 Facsimile Cover Sheet	1 page
Exhibit 7 Facsimile Confirmation	1 page
Exhibit 8 Keeling Hudson Slip Listing	1 page
Exhibit 9 Previously Submitted Statement	31 pages

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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

89

Application Number

09/904,387

Filing Date

July 12, 2001

First Named Inventor

Mark James Yunker

Art Unit

3653

Examiner Name

Daniel K. Schlak

Attorney Docket Number

ENCLOSURES

(Check all that apply)

- | | | |
|---|--|--|
| <input type="checkbox"/> Fee Transmittal Form
<input type="checkbox"/> Fee Attached
<input type="checkbox"/> Amendment/Reply
<input type="checkbox"/> After Final
<input type="checkbox"/> Affidavits/declaration(s)
<input type="checkbox"/> Extension of Time Request
<input type="checkbox"/> Express Abandonment Request
<input type="checkbox"/> Information Disclosure Statement
<input type="checkbox"/> Certified Copy of Priority Document(s)
<input type="checkbox"/> Response to Missing Parts/Incomplete Application
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Drawing(s)
<input type="checkbox"/> Licensing-related Papers
<input type="checkbox"/> Petition
<input type="checkbox"/> Petition to Convert to a Provisional Application
<input type="checkbox"/> Power of Attorney, Revocation
<input type="checkbox"/> Change of Correspondence Address
<input type="checkbox"/> Terminal Disclaimer
<input type="checkbox"/> Request for Refund
<input type="checkbox"/> CD, Number of CD(s) _____ | <input type="checkbox"/> After Allowance communication to Technology Center (TC)
<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Status Letter
<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
Renewed Petition to Withdraw Holding of Abandonment |
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Remarks

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SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

 Firm or Individual name
 Keeling Hudson, L.L.C.
 Kenneth A. Keeling

Signature

Date

8/27/03

CERTIFICATE OF TRANSMISSION/MAILING

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Typed or printed name

Kenneth A. Keeling

Signature

Date

8/27/03

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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